

REMARKS

The Office Action dated March 17, 2005, has been received and reviewed.

Claims 1-35 are currently pending and under consideration in the above-referenced application. Each of claims 1-35 stands rejected.

Reconsideration of the above-referenced application is respectfully requested.

Information Disclosure Statements

Please note that an Information Disclosure Statement was filed in the above-referenced application on April 24, 2001, and Supplemental Information Disclosure Statements were filed on June 21, 2001, and September 23, 2002, but that the undersigned attorney has not yet received any indication that the references cited in these Information Disclosure Statements have been considered in the above-referenced application. It is respectfully requested that the references cited in the Information Disclosure Statements be considered and made of record in the above-referenced application and that initialed copies of the Forms PTO-1449 and PTO/SB/08A that accompanied the Information Disclosure Statements be returned to the undersigned attorney as evidence of such consideration.

Preliminary Amendment

Also, please note that a Preliminary Amendment was filed in the above-referenced application on July 30, 2001, but that the undersigned attorney has not yet received any acknowledgement that the Preliminary Amendment has been entered into the Office file for the above-referenced application. If, for some reason, the Preliminary Amendment has not yet been entered into the Office file, the undersigned attorney would be happy to provide the Office with a true copy thereof.

Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 24-30 stand rejected under 35 U.S.C. § 112, second paragraph, for reciting subject matter that is purportedly indefinite. In particular, it has been asserted that one of ordinary skill in the art would not understand what a “respiratory flow component” is.

It is respectfully submitted that the meaning of the phrase “respiratory flow component” would be clear to one of ordinary skill in the art. This is because independent claim 1, from which claims 24-30 depend, clearly indicates that the claimed transducer is adapted to be removably securable to a respiratory flow component. Moreover, by its plain language, one of ordinary skill in the art would readily understand that the “respiratory flow component” is a component through which a respiratory sample flows.

In view of the clarity of the “respiratory flow component” recited in claim 24, claim 24, and claims 25-30 depending therefrom, are in condition for allowance under the second paragraph of 35 U.S.C. § 112. Accordingly, withdrawal of the 35 U.S.C. § 112, second paragraph, rejections of claims 24-30 is respectfully solicited.

Rejections Under 35 U.S.C. § 103(a)

Claims 1-35 stand rejected under 35 U.S.C. § 103(a).

The standard for establishing and maintaining a rejection under 35 U.S.C. § 103(a) is set forth in M.P.E.P. § 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Stanley in View of Knodle

Claims 1-10, 13-15, and 17-35 stand rejected under 35 U.S.C. § 103(a) for reciting subject matter which is assertedly unpatentable over the subject matter taught in U.S. Patent 3,725,658 to Stanley et al. (hereinafter “Stanley”), in view of teachings from U.S. Patent 4,914,720 to Knodle et al. (hereinafter “Knodle”).

It is respectfully submitted that there are at least two reasons that a *prima facie* case of obviousness has not been established against any of claims 1-10, 13-15, or 17-35.

First, without improperly relying upon the hindsight provided by the disclosure of the above-referenced application, one of ordinary skill in the art would not have been motivated to combine the teachings of Stanley and Knodle in the manner that has been asserted. Stanley teaches self-contained apparatus that employ luminescence quenching technology for detecting respiratory oxygen from side-stream respiratory samples (*i.e.*, at a remote location from the main breathing circuit). The teachings of Knodle, in contrast, are directed to two-piece (airway adapter and transducer) mainstream (*i.e.*, positioned long the main breathing circuit) infrared sensors for detecting respiratory carbon dioxide. There would be no reason to use a transducer like that taught in Knodle with a self-contained sensor of the type taught in Stanley. Moreover, the small diameter (half inch), luminescent material-coated tubes of the apparatus disclosed in Stanley would not be suitable for use in a mainstream sensor of the type taught in Knodle. Further, in the sensor of Stanley, a sample tube is coated with a luminescent material, which disrupts transmission of radiation completely through the tube, whereas the sensor of Knodle requires an unobstructed optical path through a sample cuvette.

Second, one of ordinary skill in the art would have had no reason to expect that the purported combination of Stanley and Knodle would have been successful, particularly when the teachings of these references are considered in their entireties, as required by M.P.E.P.

§ 2141.02. For example, the luminescent material-coated tube, sensor, and detector of Stanley are part of an integral unit; thus, there would be no reason to couple the transducer of Knodle to the apparatus of Stanley. Even assuming for the sake of argument that the transducer of Knodle could be coupled to the apparatus of Stanley, the wavelengths that are generated and detected by the source and detector of Knodle's transducer would not excite or detect fluorescence from the luminescent material within the apparatus that is taught in Stanley. Moreover, the presence of the luminescent material on the surfaces of the tube would likely interfere with the infrared transmission that is required to obtain respiratory carbon dioxide measurements in accordance with the teachings of Knodle. As another example, it is clear that the small diameter, luminescent material-coated tube of Stanley would not be useful in a mainstream sensor of the

type disclosed in Knodle because the small diameter of the tube described in Stanley would restrict flow of respiratory gases along the main breathing circuit, potentially interfering with other measurements taken along the breathing circuit.

It is, therefore, respectfully submitted that a *prima facie* case of obviousness has not been established against any of claims 1-10, 13-15, and 17-35. Therefore, under 35 U.S.C. § 103(a), the subject matter recited in each of claims 1-10, 13-15, and 17-35 is allowable over the subject matter taught in Stanley and Knodle.

Stanley, Knodle, and Yafuso

Claims 11 and 12 are rejected under 35 U.S.C. § 103(a) for being drawn to subject matter that is allegedly unpatentable over the teachings of Stanley, in view of teachings from Knodle and, further, in view of the subject matter taught in U.S. Patent 4,849,172 to Yafuso et al. (hereinafter “Yafuso”).

Yafuso does not remedy the aforementioned deficiencies of Stanley and Knodle. Therefore, claims 11 and 12 are both allowable, among other reasons, for respectively depending directly and indirectly from claim 1, which is allowable.

Stanley, Knodle, and Hauenstein

Claim 16 has been rejected under 35 U.S.C. § 103(a) for being drawn to subject matter which is assertedly unpatentable over that taught in Stanley, in view of teachings from Knodle and, further, in view of the teachings of U.S. Patent 4,861,727 to Hauenstein et al. (hereinafter “Hauenstein”).

Hauenstein does not remedy the aforementioned deficiencies of Stanley and Knodle. Therefore, claim 16 is allowable, among other reasons, for depending directly from claim 1, which is allowable.

CONCLUSION

It is respectfully submitted that each of claims 1-35 is allowable. An early notice of the allowability of each of these claims is respectfully solicited, as is an indication that the

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above-referenced application has been passed for issuance. If any issues preventing allowance of the above-referenced application remain which might be resolved by way of a telephone conference, the Office is kindly invited to contact the undersigned attorney.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Brick G. Power", with a long horizontal flourish extending to the right.

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